

# UNITED STATES PATENT AND TRADEMARK OFFICE



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APPLICATION NO.		FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.		
09/627,753		07/28/2000	Kenneth J Livak	4264C5	2446		
22896	7590	12/23/2002					
		TENT DEPT.	EXAMINER				
APPLIED BIOSYSTEMS 850 LINCOLN CENTRE DRIVE				RILEY,	RILEY, JEZIA		
FOSTER CITY, CA 94404				ART UNIT	PAPER NUMBER		
				1637			
				DATE MAILED: 12/23/2002			

Please find below and/or attached an Office communication concerning this application or proceeding.

•		Application	n No.	Applicant(s)							
		09/627,75	3	LIVAK ET AL.							
	Office Action Summary	Examiner	-	Art Unit							
		Jezia Rile	ey	1637							
	The MAILING DATE of this communication appears on the cover sheet with the correspondence address										
Period for Reply											
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.  - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).  - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).											
Status 1)⊠	Responsive to communication(s) filed on <u>05 L</u>	December 2	2002								
2a)□	· · · · · · · · · · · · · · · · · · ·	is action is									
3)	Since this application is in condition for allowa			nsecution as to th	e merits is						
•	closed in accordance with the practice under				e menta ia						
·	on of Claims										
-	Claim(s) <u>39 and 40</u> is/are pending in the application										
	4a) Of the above claim(s) is/are withdrawn from consideration.										
·	5) Claim(s) is/are allowed.										
·	6) Claim(s) <u>39-40</u> is/are rejected.										
·	Claim(s) is/are objected to.										
-	Claim(s) are subject to restriction and/or on Papers	r election re	equirement.								
9) The specification is objected to by the Examiner.											
10) 🔲 🛚	The drawing(s) filed on is/are: a)☐ accept	pted or b)	objected to by the Exan	niner.							
	Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).										
11) The proposed drawing correction filed on is: a) approved b) disapproved by the Examiner.											
If approved, corrected drawings are required in reply to this Office action.											
12) The oath or declaration is objected to by the Examiner.											
Priority under 35 U.S.C. §§ 119 and 120											
13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).											
a) ☐ All b) ☐ Some * c) ☐ None of:											
	1. Certified copies of the priority documents have been received.										
	2. Certified copies of the priority documents have been received in Application No										
<ul> <li>3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</li> <li>* See the attached detailed Office action for a list of the certified copies not received.</li> </ul>											
14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).											
a) The translation of the foreign language provisional application has been received.  15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.											
Attachment(s)											
2) Notice	e of References Cited (PTO-892) e of Draftsperson's Patent Drawing Review (PTO-948) nation Disclosure Statement(s) (PTO-1449) Paper No(s) <u>19</u>	<u>9</u> .		(PTO-413) Paper No atent Application (PT							

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#### **DETAILED ACTION**

#### Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/5/02 has been entered.

### Response to Remarks

2. Applicants' arguments and amendments, filed on 12/5/02, have been approved and entered. They have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either newly applied or reiterated. They constitute the complete set presently being applied to the instant application.

## **Double Patenting**

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

- 4. Claims 39 and 40 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-39 of U.S. Patent No. 5,876,930 and claims 1-12 of U.S. Patent No. 6,030,787. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are claiming the same method but not of the same scope.
- 5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jezia Riley whose telephone number is 703-305-6855. The examiner can normally be reached on 9:30AM 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 703-308-1119. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

December 22, 2002

PIMARY EXAMINER